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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,222	08/19/1999	JEFFRY JOVAN PHILYAW	PHLY-24.670	8863

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EXAMINER

THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 12/19/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
09/378,222

Applicant(s)  
Philyaw et al.

Examiner  
Marc Thompson

Art Unit  
2142



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 19, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-17, 19, and 20 is/are rejected.
- 7) ☒ Claim(s) 9 and 18 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission, Amendment C, filed on 3/19/2002, has been entered.
2. Claims 1-20 remain pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).
5. Claims 1-8, 10-17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al. (U.S. Patent Number 5,905,865), hereinafter referred to as Palmer, in view of Watanabe (U.S. Patent Number 6,163,803), hereinafter referred to as Watanabe.

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6. Palmer disclosed the invention substantially as claimed. Palmer disclosed the synchronizing of additional, related network retrieved data with digitally stored or received video and audio data. See Column 6, Lines 47-64. This retrieved information was enacted using Internet connection manipulation without human interaction, i.e. automatically. See Column 6, Lines 3-6, and Column 7, Lines 7-12. Palmer disclosed both combination of network locators in the actual video/audio signal, out of band broadcast of locators, and transmission of locators from remote sites. See Column 1, Lines 60-67, Column 2, Lines 25-33, Column 5, Lines 22-43, Column 5, Lines 59-62, and Column 8, Lines 5-19. Palmer also disclosed the use of an “intermediate node” (in the network) which received and redirected URL requests to the appropriate server(s) and compared decisions with the contents of user profiles. See Column 5, Lines 44-62, and Column 7, Lines 28-45. As discussed below (response to arguments), the URL designations were additionally resolved by DNS servers on the network in order to result in a physical address of a network device for information retrieval. Examiner takes Official Notice (see MPEP 2144.03) that DNS functionality (i.e., name to network address resolving) in a computer networking environment was well known in the art at the time the invention was made. This functionality was clearly “intermediate” and provided information directly associated with connection effecting and information transfer. Also see discussion below in response to arguments. Thus, the “playing”, “detecting”, and “assembly” of the provided information embedded within multimedia information was substantially described by Palmer in sufficient detail to enable one of ordinary skill in the art to implement the invention as broadly claimed.

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While Palmer substantially disclosed the embedding of unique resource locators (URLs) (routing information) in a digital stream of network transmitted data (Column 5, Lines 59-62), Palmer remained silent as to the specifics which would have been required to enact this type of functionality. Embedding of network locator (routing information) designations in the streamed data was mentioned as an alternate embodiment to achieve the feature of network resource and remote information synchronizing with stored or delivered digital data.

In the art of network resource encoding, Watanabe disclosed a method and system for encoding network resource locators into stored and delivered digital data for display of remotely stored related information. See Column 4, Lines 28-55. Watanabe also disclosed the embedding/encoding of network resource designators specifically with audio signals, and the extraction of the network designators during playback of the audio information. See Column 6, Lines 8-26, and Column 9, Lines 53-56. The URL signal(s) were disclosed as part of the audible signal, resulting in a "tone" and alternatively hidden from listener detection. See Column 6, Lines 59-65, and Column 7, Lines 44-49. The system also automatically retrieved the data according to the specified designator(s). See Column 9, Lines 36-42.

Incorporation of the Watanabe teachings into the teachings of Palmer would have been obvious to one of ordinary skill in the art for the simple reason that recited functionality drawn to the embedding of URL routing information into an audio stream or recording was fully described in such a way to enable the ordinary artisan to implement it. That is, the embedding of URL routing information and overall functionality drawn to delivery of audio/video associated/related

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information which was remotely stored provided by Palmer in Column 5, Line 59 through Column 6, Line 29, was fully described in detail in Watanabe, Column 4, Lines 28-55. The systems of Palmer and Watanabe were so similar, that practically identical synopsis of the inventions functionality regarding the inclusion of automatically retrieved Internet information to audio/video information were found in Palmer, Column 7, Lines 7-19, and Watanabe, Column 9, Lines 36-42.

Thus, since the teachings contain direct suggestion for combination, an individual one of the teachings would have resulted in an ordinary artisan being motivated to search the related arts, that is, the inventions being drawn to the same concept of associated Internet information delivery related with audio/video digitally stored/transmitted information, and implement a detailed description of encoding informational parameters in multimedia information for remote information retrieval. Thus, combination of the teachings would have been obvious to one of ordinary skill in the art at the time the invention was made.

Since, all limitations recited in claims 1-8, 10-17, and 19-20, were disclosed by the combination of Palmer and Watanabe, claims 1-8, 10-17, and 19-20 are rejected.

### ***Claim Objections***

Claims 9 and 18 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

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claim and any intervening claims. The detail of the system component interaction in the recited functionality is sufficient to distinguish over the prior art of record.

***Response to Arguments***

7. Applicant's arguments filed with Amendment B, have been fully considered but they are not persuasive.

8. Applicant argues two distinct features of the claimed invention in respect to distinguishing the currently claimed invention. The first of these is the alleged difference between the Palmer disclosure and the claimed "embedding" of information in a digital audio signal. The second deals with the actual information embedded within the signal(s). Both arguments will be addressed in order:

a. Applicant attempts to portray the Palmer teachings as exclusively teaching complete separation of URL data from any multimedia information which was "played" (decoded and presented) at a reception terminal. See Response, Paper #16, Page 5, Lines 1-17. This is a complete misrepresentation of the Palmer teachings. While Examiner contends that the primary embodiment has this distinction, in no way does Palmer fail to disclose this express functionality. Examiner notes Column 8, Lines 5-23, where stated, "the transmitter may [be] a traditional...AM, FM, or HAM radio station,...audio playback systems such as stereos and compact disc players and all other forms of digital, analog, or hybrid transmission capable of storing or embedding and transmitting alpha-numeric electronic addresses. For example, the URL may be stored in the vertical blanking interval of a television broadcast or sent...much like closed captioning. Just as

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closed-captioning is extracted from the signal as an alpha-numeric message, so may the URL be extracted by receiver 30 and provided to the computer.” This completely and unequivocally displays Applicant’s “playing” step as argued by Applicant, i.e., “playing at the user node the audio program having embedded therein [a unique header code].” This leads directly into the second presented argument dealing with this “unique header code”.

b. Nothing in the claim prohibits any distinction of the claimed invention from domain name server (DNS) functions. In a typical browser and networking environment, a URL is not directly routable. That is, any and all URL/URI *logical* name designations MUST resolve into an *actual, physical* network unique address, e.g., IP address, to effect connection and/or communication. Servers that perform this translation/lookup function were known as DNS server(s). These servers were “intermediate” servers, in that, any request for connection through use of a URL/URI must go to a DNS server first. Actual address information was returned and used to effect connection establishment between two networked devices. Without specific information about the structure and methodology of this “intermediate” database translating codes into addresses (or URLs) (which, incidently was also known in the prior art of record, e.g., USP 6108656 and USP 6012102), there can be no distinction made between the currently claimed invention and the applied prior art of record. It is further noted that a mere traversal of the Official Notice taken regarding the well known functionality of DNS servers must not be “bald”, that is, sufficient evidence or argument must be presented to warrant the Examiner to produce prior art to resolve any seasonable challenge to this Official Notice. The Applicant is

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entitled to traverse the Official Notice according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)."

Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Thus, arguments drawn to distinguishing these two pieces of mapped prior art to the currently claimed invention is not deemed persuasive.

c. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning (Response, Paper #16, Page 6, Lines 4-15), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the present case, the Palmer and Watanabe systems were so similar (see rejection above) that any artisan would have

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recognized both of these teachings as directly relevant during a routine search of similar systems. The combination of these teachings would have clearly resulted in a more specified description of the alleged generalized teachings of the claimed invention. See Response, Paper #16, Page 6, Lines 4-10.

***Information Disclosure Statement***

9. Information disclosure statement (IDS), Paper #6, are being resupplied to Applicant, after removal of duplicate references submitted on both IDSs. The references listed on Paper #6, which were previously listed on Paper #5, have been removed from the IDS itself to eliminate the possibility of duplicate printing should the application pass to issue. It is unknown whether Applicant received this duplicate copy of Paper #6, since it was noted within the file during this examination.

10. It should be noted that the applicant has submitted an exorbitant amount of prior art on numerous PTO-1449's which on initial consideration appears to not all have relevancy or pertinence to the instant invention as claimed. The applicant was requested in response to the last Office Action (Paper #14) to point out which of these numerous prior art are pertinent or relevant to the patentability of the invention as claimed in this instant application, and have declined to do so. See Response, Paper #16, Page 7, Lines 7-8.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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a. Byford (U.S. Patent Number 6,097,375) disclosed the use of audio signals to enact remote connection and communication of information over a network.

12. Applicant has had numerous opportunities to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP §2111. Applicant employs broad language which includes the use of words and phrases which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. As a courtesy to the Applicant, the above action is made NON-FINAL to enable Applicant to respond without undue burden, wherein a First-Action Final Office Action would normally be appropriate (See MPEP 706.07(b)).

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14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc Thompson whose telephone number is (703) 308-6750. The Examiner can normally be reached on Monday-Friday from 9am to 4pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark Powell, can be reached at (703) 305-9703.

The fax phone numbers for the organization where this application is assigned are as follows:

(703) 746-7238	(After Final Communications only)
(703) 746-7239	(Official Communications)
(703) 746-7240	(for Official Status Inquiries, Draft Communications only)

Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900.

**MARC THOMPSON**  
Marc D. Thompson  
Patent Examiner  
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